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09/928,314	08/13/2001	Tim J. Corbett	2688.5US (93-0318.7)	7920
24247	7590	03/23/2005	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			FOURSON III, GEORGE R	
			ART UNIT	PAPER NUMBER
			2823	

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Please find below and/or attached an Office communication concerning this application or proceeding.

BEFORE THE BOARD OF PATENT APPEALS

AND INTERFERENCES

Application Number: 09/928,314

Filing Date: August 13, 2001

Appellant(s): CORBETT, TIM J.

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Brick G. Power

For Appellant

EXAMINER'S ANSWER

**MAILED**

**MAR 23 2005**

**GROUP 2800**

This is in response to the appeal brief filed 7/2/04 appealing from the Office action mailed 6/9/03.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection is substantially correct. The changes are as follows: Applicant fails to include Appellant's admitted prior art (AAPA) in the list of evidence relied on in rejecting claims 19-23 under 35 U.S.C. 103.

Also, in applicant's "Grouping of Claims" applicant mistakenly includes claim 19 in group I. Group I should be claims 1-18 because claims 1-18 are rejected under 35 USC 103 over Folk in view of Meneghini.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

### **(8) Evidence Relied Upon**

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

5757313	MENEHINI	5-1998
4594263	FOLK	6-1986
5256578	CORLEY	10-1993

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Folk in view of Meneghini.

Folk discloses marking of qualified semiconductor packages subsequent to testing and packaging as the last step in the production process (col.1, lines 22-24). The reference does not disclose thermal transfer ink printing using a laser to create the mark including providing an energy reactive marking material over the surface of the semiconductor chip.

Meneghini discloses thermal transfer ink printing using a laser to mark semiconductor devices including providing an energy reactive marking material over the surface of the semiconductor chip (col.1, lines 113-15 and col.1, line 62 – col.2, line 13).

Both Folk and Meneghini are directed to marking of semiconductor devices and are therefore analogous.

It would have been within the scope of one of ordinary skill in the art to combine the teachings of Folk and Meneghini to enable the marking step of Folk to be performed according to the teachings of Meneghini because one of ordinary skill in the art would have been motivated to look to analogous art teaching suitable or useful alternative methods of performing the disclosed marking step of Folk and art recognized suitability for an intended purpose has been recognized to be motivation to combine. MPEP 2144.07. One of ordinary skill in the art would have had a reasonable expectation of success when substituting the marking process of Meneghini for the marking process of Folk in view of the teachings of Meneghini that the process disclosed therein is suitable for marking semiconductor devices as well as other materials such as audio cassettes, computer diskettes and syringe bodies (col.1, line 15).

Claims 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Folk in view of Meneghini as applied to claims 1-18 above, and further in view of appellant's admitted prior art (AAPA) and Corley.

The process of Folk in view of Meneghini does not include reworking marks considered to be necessary of reworking.

Appellant admits that smudging of ink marks and deterioration of the quality of marks over time resulting from changes in stamp surface condition or from removal due to abrasion was known prior to appellant's invention (instant pages 2 and 3). In both cases, it is inherent that a comparison between an ideal/acceptable mark and the actual mark in question is being discussed. Corley discloses that marks can smear or fall off, resulting in incorrectly marked die, and removal of the mark using a solvent (col.1, lines 30-40). It would have been obvious to one of ordinary skill in the art to combine the teachings of Folk and Meneghini with those of AAPA and Corley to remove the unacceptable mark of the prior art process using

the process of Corley, because it is disclosed by AAPA and Corley as non-useful, and then to form the mark of the process made obvious by the combination of AAPA, Folk and Meneghini in that location because the removal step would enable providing a useful location to perform the process of forming the mark by laser transfer ink printing.

**(10) Response to Argument**

Appellant argues that Folk teaches a method of marking the devices other than laser marking as recited. However, the additional teachings of the reference do not negate those relied on in the rejections of claims 1-23 above, namely marking of qualified semiconductor devices.

Appellant argues that Folk discloses electroless plating as superior to ink and polymer marking processes and that use of ink and polymers is therefor undesirable. Appellant argues that this is a teaching away from the relied on combination of references. However, this is not a disclosure that use of ink and polymer marking would render the process inoperable and therefor cannot be used in the process. Instead, this is a disclosure that the process would be operable using ink and polymer marking and would result in the disclosed concomitant disadvantages. Although not taught as a preferred embodiment, Folk teaches this embodiment nonetheless, and disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). Even a teaching away from a claimed invention does not render the invention patentable. See Celeritas


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Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998), where the court held that the prior art anticipated the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed." To further clarify, a prior art opinion that a claimed invention is not preferred for a particular limited purpose, does not preclude utility of the invention for that or another purpose, or even preferability of the invention for another purpose.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

George Fourson



George Fourson  
Primary Examiner

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